

REMARKS

Claims 1-20 are presented for examination.

Examiner Interview

The undersigned contacted the Examiner on October 9, 2007 to discuss the claims and the prior art references. The undersigned reiterated the arguments presented in the previous Response. No agreement was reached.

§103 Rejections

In the Final Office Action, the Examiner rejected claims 1-20 under 35 U.S.C. 103(a) as being unpatentable over US Patent Application 2002/0174355 (*Rajasekaran*) in view of *Song et al.* Applicants respectfully traverse this rejection.

A. Independent claims 1, 8 and 15 (including their dependent claims) are Allowable

1. The cited references do not teach all of the claimed features

For ease of illustration, claim 15 is discussed first. Claim 15 calls for a control unit that is adapted to access one or more terms associated with one or more remote files over a network and encrypt one or more of the terms. Claim 15 further calls for the control unit to receive an encrypted search term from a user, compare the received encrypted search term with the encrypted accessed terms, and provide a result of the comparison over the network.

The Examiner relies on the combination of *Rajasekaran* and *Song* to reject claim 15 under 35 USC 103 for obviousness. Specifically, the Examiner argues that *Rajasekaran* discloses accessing terms over a network, and *Song* discloses receiving an encrypted search term and comparing it to the encrypted accessed terms. See Final

Office Action, p. 2. Further, the Examiner asserts that the last claimed feature of providing a result of the comparison is taught by *Rajasekaran*. *Id.*

It is well established that, to establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach all the claimed features. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). Moreover, each of the claimed features must be disclosed identically in the prior art. In the present case, the Examiner has failed to show that the cited references disclose each and every claimed feature identically. For example, although the Examiner asserts that *Rajasekaran* discloses the claimed feature of “providing a result of the comparison to the user,” a review of *Rajasekaran* reveals otherwise. The term “comparison” in this claimed feature derives its antecedent basis from the previous claimed feature, which specifies comparing the received encrypted search term with the encrypted accessed terms. *Rajasekaran* does not disclose such a comparison, and, therefore, cannot and does not disclose the last feature of providing a result of the comparison, as specified in claim 15.

In *Rajasekaran*, the search term (which the Examiner asserts corresponds to the “search term” in block 208) is not encrypted. *See Rajasekaran*, ¶44 (describing that the unencrypted search term is compared to a decrypted “data structure”). Thus, *Rajasekaran* discloses providing a result based on a comparison of an unencrypted search term to a decrypted data structure, whereas the claims call for providing a result of a comparison between an encrypted search term and encrypted accessed terms. For at least this reason, the *Rajasekaran* does not disclose the claimed feature of providing a result of the comparison (i.e., the comparison between two encrypted terms). Claim 15 (and its dependent claims) and the other pending claims are allowable for at least this

reason. For similar reasons, claims 1 and 8 (and their respective dependent claims) are also allowable.

2. Response to Examiner's Argument

In the previous Response, the Applicants pointed out that, contrary to the Examiner's assertion, *Rajasekaran* does not disclose providing a result of the comparison to the user. In the Final Office Action, the Examiner ignores the Applicants' argument, and instead responds by asserting that *Song* discloses searching of encrypted terms. See Final Office Action, p. 2. The Examiner's response, unfortunately, misses the point.

The Examiner has now twice taken the position that *Rajasekaran* teaches the last claim feature of "providing a result of the comparison." See First and Final Office Actions. For the Examiner's rejection to be proper, *Rajasekaran* must teach this feature exactly. As explained above, however, *Rajasekaran* simply does not disclose providing a result of the comparison (where the comparison is between an encrypted search term and encrypted accessed terms). If anything, it teaches the opposite – providing results based on a comparison between an unencrypted search term and a decrypted data structure. See *Rajasekaran*¶44 (describing that the unencrypted search term is compared to a decrypted "data structure"). The Examiner's position that *Rajasekaran* teaches "providing a result of the comparison" is thus belied by the reference itself.

B. The cited references teach away from the claimed combination

It is well established that where a modification or combination renders a prior art reference inoperable for its intended purpose, the reference teaches away from the modification or combination. *In re Gordon*, 221 U.S.P.Q. (BNA) 1125, 1127 (Fed. Cir. 1984). Such as is the case here. Although the Examiner relies on a combination of

Rajasekaran and *Song* to reject the claims, these references, in fact, teach away from the claimed combination. The Examiner asserts that *Song* discloses receiving an encrypted search term and comparing it against a collection of encrypted terms. In other words, according to the Examiner, the comparison is between an encrypted search term and a collection of encrypted terms. *Rajasekaran*, on the other hand, teaches exactly the opposite. In particular, as discussed earlier, *Rajasekaran* discloses receiving an unencrypted search request (at block 208) and comparing that search request against a collection of search terms (“data structure” in block 205) that are first decrypted (at block 210). That is, *Rajasekaran* discloses that the “data structure” to which the search term is being compared must first be decrypted.

Thus, in contrast to *Song*, *Rajasekaran* teaches first decrypting the corpus of terms before any comparison. To modify the teachings of *Rajasekaran* in view of *Song* in the manner proposed by the Examiner would, therefore, render the searching scheme described in *Rajasekaran* inoperable for its intended purpose (i.e., being able to compare an unencrypted search request against a decrypted data structure). As such, *Song* teaches away from the modification or combination, thereby establishing a prima facie case of non-obviousness. *See In re Gordon* at 1127 (where a modification or combination renders a prior art reference inoperable for its intended purpose, the reference teaches away from the modification or combination, and thus making the claimed combination non-obvious).

C. Claims 4 and 18 are Allowable

Dependent claims 4 and 18 are allowable for at least the reasons their respective independent claims are allowable, as discussed above. Moreover, these claims are

allowable for additional features recited therein. For example, claim 4 specifies that “accessing” step of claim 1 comprises accessing one or more terms contained in hypertext markup file(s) stored in one or more workstations coupled to the network. As indicated in claim 1, these accessed terms are thereafter encrypted.

With respect to claim 4, the Examiner argues that *Rajasekaran* discloses using “the internet and other readable formats being used.” See Final Office Action, p. 3. Even assuming that the Examiner’s assertion is true (that the reference discloses using Internet and other readable formats), such a disclosure does not teach the feature recited in claim 4. Claim 4 does not simply recite using Internet (or other readable formats). Rather, as noted, claim 4 specifies accessing one or more terms contained in hypertext markup file(s), where, as specified in claim 1, these terms are thereafter encrypted. *Rajasekaran* does not even mention hypertext markup files, much less how one or more terms in these files are accessed, as specified in claim 4. Although the Examiner argues that *Rajasekaran* discloses using “Internet or other readable formats,” even the Examiner (and rightly so) does not contend that *Rajasekaran* discloses accessing one or more terms contained in hypertext markup file(s).

The Examiner points to paragraph 0006 of *Rajasekaran* in rejecting claim 4. While this paragraph makes a reference to text files and documents being in “readable, known formats,” it explicitly states that these files are “not encrypted.” In contrast, as noted, claim 4, when read in light of its independent claim 1, specifies encrypting one or more terms accessed from the hypertext markup file(s). For at least the aforementioned reasons, claim 4 is allowable. For similar reasons, claim 18 is allowable.

D. Claims 7, 13, and 20 are Allowable

Dependent claims 7, 13, and 20 are allowable for at least the reasons their respective independent claims are allowable, and further for the claimed features recited therein. For example, claim 20, which depends from claim 15, specifies the use of two databases (one for storing unencrypted accessed terms and the other for storing encrypted accessed terms) and further for providing a user with an option to search either of the two databases. The Examiner asserts that this feature is taught by *Rajasekaran* because it discloses a storage system having two memory subsystems. See Office Action, p. 4. Even assuming that the two memory subsystems correspond to “databases,” *Rajasekaran* still fails to teach that these memory subsystems are for storing both encrypted and unencrypted accessed terms. Moreover, *Rajasekaran* does not disclose providing a user with an option to search either the first or the second database. For at least this reason, claim 20 is allowable. Moreover, dependent claims 7 and 13 are allowable for at least the same reasons.

Reconsideration of the present application is respectfully requested. In light of the arguments presented above, a Notice of Allowance is respectfully solicited. If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the Houston, Texas telephone number (713) 934-4064 to discuss the steps necessary for placing the application in condition for allowance.

Respectfully submitted,

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